

REMARKS

Attorney for Applicants has carefully reviewed the outstanding Office Action on the above-identified application. Applicants have amended the application as set forth herein, and submit that the application, as amended, is in condition for allowance.

Applicants have amended the paragraph beginning on line 18 on page 16 of the specification to address the informality noted in the Office Action with respect to that paragraph. Specifically, the correct reference numeral 10 referring to the electronic communication service of the present invention was added.

In response to the prior Restriction Requirement, Applicants elected for prosecution the invention set forth in claims 1-28 and 34-44, and filed a divisional application directed to the subject matter of claims 29-33. Claims 29-33 were withdrawn from consideration in the present case. Accordingly, Applicants have cancelled claims 29-33.

Applicants respectfully traverse the rejection raised in the Office Action with respect to claims 6-7 under 35 U.S.C. § 112 as failing to enable one of ordinary skill in the art to practice the feature of the present invention of sorting direct mail advertising materials. The Office Action incorrectly states that the present invention "requires manipulation of the postal system to sort out the postal mail delivered to the end users." However, no such requirement is stated anywhere in the specification, nor is the postal system required to carry out Applicants' claimed invention. While the postal system can be used by the present invention to send advertisements, conventional and electronic advertisements are sorted by the present invention, and not the postal

system, prior to mailing. As such, the postal system is not required for the claimed invention to operate. Moreover, direct mail advertising conducted by the present invention need not be confined to use of the conventional postal system, as suggested by the Office Action. Rather, direct mail advertising can be sent electronically, and/or by conventional postal mail.

Further, the specification is replete with examples of how sorting of both electronic and direct mail advertising materials (*e.g.*, offers) is achieved by the present invention. *See, e.g.*, page 17, lines 3-6 ("...business offers are processed from information regarding an offer type, the products or services to which the offer pertains, where the product or service is sold or offered, any targeted recipients, selection criteria, the method of conveying the offer, and the time period for which the offer lasts."); page 19, lines 13-21 ("...offer definition step 30 gathers from the user instructions on how the offer is delivered and to whom it is extended via step 62, whereby the user is prompted to provide information regarding recipient lists (achieved by selecting from registered users or other private lists), selection criteria (achieved by selecting from special interest category lists or geographic regions, or both), method of extending offer (achieved by selecting from the options of targeting all registered users with interest, open offer to all users, open offer to all users with interest, e-mail to non-registered users with public e-mail ID's, postal alert cards where no matches are identified, or postal alert card where no matching e-mail ID's are found)"). Accordingly, Applicants respectfully submit these claims comply with the enablement requirements of 35 U.S.C. § 112, and request withdrawal of the rejection of these claims.

Applicants further respectfully traverse the rejection of claims 10 and 25 as failing to comply with the enablement requirement of 35 U.S.C. § 112. Claims 10 and 25 both recite the step of allowing users to browse offers matched and unmatched to a user's categories of interest. In connection with these claims, the Office Action incorrectly states that the specification fails "to teach the specific methods which allow the unmatched mail advertisements to be viewed." Clearly, as set forth in the specification, a user can match mail to any number of categories of interest, and then view mail with a web browser or mail viewer as is very well known in the art. Moreover, the specification clearly provides that newsgroups can be used to view matched and unmatched (*e.g.*, solicited and unsolicited) offers using newsgroups. For example, the specification states on page 16 at lines 5-7 that " the user has the option of viewing both solicited and unsolicited offers, and electronic mail may be selectively downloaded through the use of newsgroup services." Accordingly, Applicants respectfully submit that claims 10 and 25 comply with the enablement requirements of 35 U.S.C. § 112, and request withdrawal of the rejection of these claims.

Applicants have amended the last paragraph of page 37 of the specification to overcome the rejection of claims 14-16 as failing to comply with the written description requirement of 35 U.S.C. § 112. Claims 14-16 provide that the present invention can charge businesses for sending direct mail advertising materials, and that such charges could be based on the amount of direct mail advertising materials sent, or the amount of direct advertising materials received by users. The last paragraph of page 37, as amended herein, now recites that "Business can be charged for sending direct mail advertising materials. Such charges could be based on the amount of direct mail advertising materials sent, or the amount of direct mail advertising materials received by the

user." Support for this amendment is found in claims 14-16, which were originally presented in the application as filed. Accordingly, no new matter is introduced by this amendment. See MPEP § 2163.06 III ("if an application as originally filed contains a claim disclosing material not disclosed in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter") (citing *In re Benno*, 768 F.2d 1340, 226 U.S.P.Q. 683 (Fed. Cir. 1985)). Therefore, Applicants submit that claims 14-16 now comply with the written description requirement of 35 U.S.C. § 112.

Applicants' claimed invention relates to an electronic communication service. The invention provides an electronic communication service method comprising the steps of: subscribing users to the electronic communication service using conventional name and conventional postal address information; subscribing businesses to the electronic communication service; receiving direct mail advertising materials from the businesses; and sending the direct mail advertising materials to the users over the Internet using the conventional name and conventional postal address information. (Claim 1)

Applicants' claimed invention further provides an electronic communication service method for a user comprising the steps of: subscribing to the electronic communication service through a user interface using conventional name and conventional postal address information; obtaining an account; providing user preferences; and receiving over the Internet mailing information offered by businesses over the electronic communication service and matched to said user preferences based upon said conventional name and said conventional postal address information. (Claim 18)

Further, Applicants' claimed invention provides an electronic communication service method for a business comprising the steps of: subscribing to the electronic communication service; obtaining a business account; providing direct mail advertising materials from the business to the electronic communication service; providing conventional name and conventional postal address information from the business to the electronic communication service; and allowing the service to send said direct mail advertising materials to a plurality of users over the Internet using said conventional name and said conventional postal address information provided by the business. (Claim 26)

Moreover, Applicants' claimed invention provides a method of providing an electronic communication service at a remote location comprising the steps of: providing software at the remote location; subscribing users at the remote location using conventional name and conventional postal address information; subscribing businesses to the electronic communication service; receiving direct mail advertising materials from the businesses at the remote location; connecting the remote location to the electronic communication service; and sending the direct mail advertising materials to the users over the Internet using the conventional name and conventional postal address information. (Claim 34)

Additionally, Applicants' claimed invention provides an electronic communication service apparatus comprising: means for subscribing users to said electronic communication service apparatus using conventional name and conventional postal address information; means for subscribing businesses to said electronic communication service apparatus; means for receiving direct mail advertising materials from said businesses; and means for targeting said

direct mail advertising materials to said users over the Internet using said conventional name and said conventional postal address information; wherein when said users and said businesses are subscribed to said electronic communication service apparatus, said direct mail advertising materials are retrieved from said businesses and targeted to said users. (Claim 37)

Applicants submit that claims 18, 20-23, and 25, which were rejected as being anticipated by U.S. Patent No. 6,108,691 to Lee, are patentable over this reference.

Lee discloses a directory with options for access to and display of e-mail addresses. The invention allows a user to receive e-mail messages from senders without requiring the user to reveal an e-mail address. E-mails can be exchanged between senders and recipients without revealing the recipients' e-mail address. Users can access promotional materials from a promotions database.

Lee fails to disclose each element of Applicants' claimed invention as set forth in amended independent claim 18. Specifically, Lee fails to disclose **receiving over the Internet direct mail advertising materials ... using conventional name and conventional postal address information**, as set forth in amended claim 18. While Lee discloses allowing users to exchange e-mails without disclosing the users' e-mail addresses, Lee fails to allowing recipients to receive direct mail advertising materials sent to the recipients over the Internet using conventional name and postal address information. Further, while Lee provides a promotions database wherein users can log in to retrieve promotional material from businesses, Lee is wholly unconcerned with providing direct mail advertising materials to recipients over the

Internet. As such, Applicants submit that independent claim 18 and claims 20-23 and 25, which depend from amended claim 18 and contain all of the limitations thereof, are patentable over Lee.

Applicants submit that claims 1-4, 6-13, 19, 24, 26-28, 34-36, and 37-44, which were rejected as being obvious over Lee in view of the article to Murray entitled "Evaluating Web Impact -- The Death of the Highway Metaphor," are patentable over these references.

Murray discloses a three-step methodology for understanding the impact that an Internet website has on viewers. The first step comprises creating an exchange between the website and visitors. The second step comprises engaging the visitor and inviting the customer to provide feedback on the website. The third step comprises gathering and evaluating the feedback.

Neither Lee nor Murray, taken alone or in combination, teach or suggest each element of Applicants' claimed invention, as set forth in independent claims 1, 18, 26, 34, and 37. Specifically, neither Lee nor Murray, taken alone or in combination, teach or suggest providing **direct mail advertising materials over the Internet using conventional name and conventional postal address information** provided by recipients, as set forth in claims 1, 18, 26, 34, and 37. Lee fails to teach or suggest providing direct mail advertising materials to recipients over the Internet using conventional name and conventional postal address information. Rather, Lee merely provides a system for allowing e-mails to be exchanged without disclosing a recipient's e-mail address. Further, while Lee discloses a promotions database

where users can retrieve promotional material posted by businesses, Lee is wholly unconcerned with providing direct mail advertising materials to users using the Internet.

Murray fails to cure the deficiencies of Lee. While Murray mentions the possibility of combining direct database marketing techniques and established research methodologies, Murray fails to teach or suggest providing direct mail advertising materials to recipients over the Internet using conventional name and conventional postal address information. Rather, Murray specifically encourages using e-mail to allow for communications between businesses and website visitors, a goal that requires users to divulge their e-mail addresses and which is entirely antithetical to the goal of present invention. Moreover, the entire thrust of Murray is directed to measuring the effectiveness of a website, and not providing direct advertising materials to recipients over the Internet using conventional name and conventional postal address information. As such, Applicants submit that independent claims 1, 18, 26, 34, and 37 and claims 2-3, 6-13, 19, 24, 27-28, 35-36, and 38-44, which depend from claims 1, 18, 26, 34, and 37 and contain all of the limitations thereof, are patentable over Lee and Murray, taken alone or in combination.

Applicants submit that claims 14-17, which were rejected as being obvious over Lee in view of Murray and an article Brian entitled "UK Case Study: The Postal Preference Service," and the Examiner's Official Notice, are patentable over these references.

Brian discloses a postal preference service, wherein consumers are surveyed as to the types of mail they desire to receive, as well as the types of mail that they do not desire to receive.

Companies are then contacted on behalf of the consumers, so that appropriate companies are matched to consumers who desire to receive specific types of mail. Thereafter, targeted mailings are conducted by the companies to interested consumers, and preferences are updated on a yearly basis.

The Official Action takes Official Notice that "charging a fee for registered conversion services is notoriously well known for the advantage of keeping the service from going out of business." Applicant traverses such Official Notice. Claims 14-17 are directed to charging business for sending direct mail advertising materials, and not "registered conversion services" as the Office Action incorrectly states. Further, charging businesses for sending direct mail advertising materials in connection with an electronic communication service is not the type fact that is "capable of instant and unquestionable demonstration as being 'well-known' in the art," as required by MPEP § 2144.03, that would warrant a taking of Official Notice.

Neither Lee, Murray, Brian, nor the Official Notice, taken alone or in combination, teach or suggest Applicants' claimed invention as set forth in claims 14-17. Claims 14-17, which depend from independent claim 1, each recite the step of **sending direct mail advertising materials to users over the Internet using conventional name and conventional postal address information**. Both Lee and Murray are absent any teaching, suggestion, or motivation to send direct mail advertising materials over the Internet using conventional name and conventional postal address information. Brian fails to cure the deficiencies of Lee and Murray. While Brian teaches providing targeted direct mail advertising to recipients based upon consumers' mail preferences, Brian is wholly devoid of any teaching, suggestion, or motivation

to provide direct mail advertising materials to users over the Internet using conventional name and conventional postal address information. The Official Notice is unconcerned with sending direct advertising materials to users of the Internet using conventional name and conventional postal address information. Accordingly, Applicants submit that claims 14-17 are patentable over Lee, Murray, Brian, and the Official Notice, taken alone or in any combination.

Finally, Applicants submit that claim 5, which was rejected as being obvious over Lee in view of Murray and an article by Resnick entitled "Direct Marketing Online to Avoid Spam, Check Source of E-mail Lists," is patentable over these references.

Resnick discloses guidelines set forth by the Federal Trade Commission for e-mail opt-in lists. The article mentions guidelines for compiling targeted lists of e-mail recipients from newsgroup and Internet discussion group participants.

Neither Lee, Murray, nor Resnick, taken alone or in combination, teach or suggest each element of Applicants' claimed invention as set forth in claim 5. Claim 5, which depends from independent claim 1, recites the step of **sending direct mail advertising materials to users over the Internet using conventional name and conventional postal address information.** Both Lee and Murray, are absent any teaching, suggestion, or motivation to send direct mail advertising materials over the Internet using conventional name and conventional postal address information. Resnick fails to cure the deficiencies of Lee and Murray. Resnick is wholly devoid of any teaching, suggestion, or motivation to provide direct mail advertising materials to users over the Internet using conventional name and conventional postal address information.

Accordingly, Applicants submit that claim 5 is patentable over Lee, Murray, and Resnick, taken alone or in any combination.

All issues raised in the Office Action are believed to have been addressed. Claim 18 was amended and claims 29-33 were cancelled. Claims 1-28 and 34-44 are pending in this application. Re-examination is requested and favorable action solicited.

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